

Remarks

Reconsideration of this application is respectfully requested.

As an initial matter, Applicant has cancelled claim 33, and amended the preambles to claims 34 – 38 to clarify the claims from which dependency was intended.

Claims 1 – 38 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,893,074 issued to Hughes et al (“Hughes”). With respect to the Action’s rejection of claims 1, 6, 11, 16, 21, and 26, Applicant has amended those claims to include, among other things, “providing candidate data representing attributes of candidates for the” task/item “responsible person, the candidate data comprising candidate names, field of expertise, workload and contact information.” Support for these amendments can be found in the specification at paragraphs 0022 and 0032 and in Figures 3 and 4. Nowhere within Hughes is this feature disclosed or suggested. Additionally, contrary to the Action’s allegation, nowhere in Hughes is there disclosed or suggested a person having or being provided read-only access to the task/item report as is claimed in Applicant’s claims 1, 6, 11, 16, 21, and 26.

Anticipation under 35 U.S.C. § 102 requires that each and every element of the invention defined in the claim must be met in a single prior art reference. MPEP § 2131; *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). The Action alleges at page 4, with respect to claims 1, 6, 11, 16, 21, and 26, that Hughes discloses “means for permitting at least one other person to have read-only access to the task report” and further cites as support for such allegation, Hughes column 8, lines 10 – 13. The Action is incorrect in the allegation. Hughes,

column 8, lines 10 – 13 refers to the middle of a box of comments under the title “DATES NOT AGREED STATE” and states “The product was reconciled. The supplier cannot make the original agreed-to delivery date, and has changed it to a later date” Nowhere in this statement is any reference of any kind made to a person having or being provided read-only access to a task or item report. Furthermore, the comment explicitly states that the supplier has changed the delivery date in the system, clearly an example of read-write capability, not read-only access. In fact, Hughes is directed to providing the work force involved with the project control over editing, updating, and distribution information relevant to their particular task. At column 6, lines 5 – 8, Hughes states, “In this way management of the project is distributed over and controlled by the project’s entire work force, with each employee directly controlling his or her contract.” (emphasis added). And at column 2, lines 32 – 34, Hughes states, “The combination of these features [of Hughes’ invention] allows users to quickly and easily supply input data and access output data.” (emphasis added). Also, at column 3, lines 22 – 25, Hughes states, “All levels of the project’s suppliers and receivers- . . . –can use the schedule-control method to control and iterate their portion of the project.” (emphasis added). Thus, Hughes fails to teach or suggest a person having or provided read-only access to a task/item report, a feature present in Applicant’s claims 1, 6, 11, 16, 21, and 26. Therefore, the Action fails to show that each and every element of these claims is present in Hughes. Accordingly, anticipation under § 102 has not been established in the Action, and the rejection should be withdrawn.

Applicant has also amended claims 1, 6, 11, 16, 21, and 26 to add a feature not taught or suggested by Hughes; namely, “providing candidate data representing attributes of candidates for the” task/item “responsible person, the candidate data comprising candidate names, field of expertise, workload and contact information.” Hughes does not disclose this feature because the

tasks/contracts taught by Hughes are between suppliers and receivers that are pre-defined based upon the parameters of the product to be manufactured and supplied. For instance, at column 4, lines 30 – 34, Hughes states, “This format effectively separates the project into a series of smaller tasks, each of which involves a contract between a supplier and a receiver. Each contract relates in some way to the production of a product.” (emphasis added). Additionally, Figure 2A in Hughes schematically depicts the tasks to be completed, as among groups A – D, where the product to be manufactured or supplied is defined by the group supplying the product and the group receiving the product. This teaching of the product to be produced as the driving component of the schedule-control method of Hughes is the essence of the “rec/del” or “receivable/deliverable” format which is the core disclosure of Hughes as stated in column 2, lines 3 – 16. Thus, the attributes of candidates for a task or item being used to select a task/item-responsible person, as defined by Applicant in claims 1, 6, 11, 16, 21, and 26, is not disclosed or suggested by Hughes. In fact, Hughes teaches away from this feature, because in Hughes the product to be received or delivered drives the selection of the task-responsible person or group, whereas in claims 1, 6, 11, 16, 21, and 26, the attributes of the candidate determines the selection of the task/item responsible person. Thus, Hughes fails to teach or suggest a limitation present in Applicant’s claims 1, 6, 11, 16, 21, and 26, and therefore the Action fails to show that each and every element of Applicant’s these claims is present in Hughes. Accordingly, the rejection of claims 1, 6, 11, 16, 21, and 26 should be withdrawn.

Claims 2 – 5 are dependent from claim 1, claims 7 – 10 are dependent from claim 6, which depends from claim 1, claims 12 – 15 are dependent from claim 11, claim 17 – 20 are dependent from claim 16, which depends from claim 11, claims 22 – 25 are dependent from claim 21, and claims 27 – 30 are dependent from claim 26, which depends from 21, and all

Appl. No.: 10/616,517
Amtd. dated 5/8/2006
Reply to Office Action of February 8, 2006

should all be allowable at least for the same reasons as claims 1, 6, 11, 16, 21, and 26..

Withdrawal of the rejection to these claims is requested.

With respect to the rejection of claim 31, Applicant has amended the claim to particularly and distinctly claim, among other things, that the opinion is specifically a “patent opinion,” and further that “patent-related data comprises at least the patent claims and the patent specification.” With respect to the rejection of claim 32, Applicant has amended the claim to particularly and distinctly claim that “patent data comprises at least the patent claims, the patent specification and the patent abstract.” Support for these amendments can be found in the specification at paragraphs 0042 – 0049, and more specifically at paragraphs [0042] [0044], [0045], and [0049].

Nowhere within Hughes is there a disclosure, teaching or suggestion of a “patent opinion” as claimed by Applicant in claim 31.

The term “opinion” as it is used in the art of patenting or patent law is well understood to mean a specific type of analysis performed by a qualified individual, typically a patent attorney, regarding a legal question or issue relating to a patent. This analysis is typically relayed to the requesting party in the form of a written conclusion (or opinion) as to the likelihood of certain outcomes to the legal question at issue with the patent. See Underwater Devices, Inc. v. Morrison-Knudsen Co., 717 F.2d 1380, 1390 (Fed. Cir. 1983). Thus, the term “patent opinion” as used in Applicant’s claim 31 is clearly a very specialized type of report or analysis, relating to the field of patenting or patent law, and in no way is present in any manner in Hughes. Hughes fails to teach or suggest such a feature present in Applicant’s claim 31, namely a “patent opinion” and therefore the Action fails to show that each and every element of claim 31 is

present in Hughes. Accordingly, anticipation under § 102 has not been established in the Action with respect to claim 31, and the rejection of claim 31 should be withdrawn.

Similarly, the features “patent-related data comprises at least the patent claims and the patent specification” or “patent data comprises at least the patent claims, the patent specification and the patent abstract” as used in Applicant’s claims 31 and 32, respectively, refer to a type of data that is wholly absent in Hughes. The particular features “patent claims,” “patent specification,” and “patent abstracts,” as used in Applicant’s claims 31 and 32 are specialized written disclosures used within the field of patenting of inventions. There are no disclosures anywhere in Hughes teaching or suggesting anything remotely related to patents; in fact, the term “patent” or any derivation thereof is never used throughout the entire Hughes reference. Specifically, Hughes is silent with respect to teaching or disclosing “patent claims,” “patent specifications,” and “patent abstracts.” Additionally, any allegation in the Action that “input data,” “output data,” “comments,” “responses,” “work package agreements (WPAs),” “project descriptions,” or “reports” as these terms are used in Hughes, are analogous to “patent claims,” “patent specifications,” or “patent abstracts” as defined in either of Applicant’s claims 31 or 32, is inaccurate. Thus, Hughes fails to teach or suggest limitations present in Applicant’s claims 31 and 32, namely, “patent-related data comprises at least the patent claims and the patent specification” and “patent data comprises at least the patent claims, the patent specification and the patent abstract.” Therefore the Action fails to show that each and every element of Applicant’s claims 31 and 32 is present in Hughes. Accordingly, anticipation under § 102 has not been established in the Action, with respect to claims 31 and 32, and the rejections of these claims should be withdrawn.

Appl. No.: 10/616,517
Amdt. dated 5/8/2006
Reply to Office Action of February 8, 2006

Claims 34 – 38 are dependent from claim 32, and should all be allowable at least for the same reasons as claim 32. Withdrawal of the rejection to these claims is requested

New claims 39 - 42 are dependent on claim 31, and should be patentable for at least the same reasons as claim 31. In addition, the prior art of record neither discloses nor suggests the additional features of claims 39 - 42. Support for claims 39 – 42 is provided by paragraphs [0042] and [0045]. No new matter is added.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to that effect is respectfully requested.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

Respectfully submitted,

Dated: 5-8-06


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